



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,133	09/06/2005	Lone Andersen	GRP-0103	2555
23413 7590 02/25/2008 CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103			EXAMINER CORBIN, ARTHUR L	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 02/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,133	Applicant(s) ANDERSEN ET AL.	
	Examiner Arthur L. Corbin	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03-23&08-29-05;05-22,07-26&11-13-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,22-26 and 28-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,22-26 and 28-42 is/are rejected.
- 7) ☒ Claim(s) 18,23,25 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:032305,082905,062206,072606,111306.

Art Unit: 1794

1. Claims 18, 23, 25 and 41 are objected to because of the following informalities:

In claim 18, line 4, the third comma should be changed to "or". In claim 23, penultimate line, "magnesiumoxide" should be two words, "and or" should be changed to "and/or" and "or derivates" should be cancelled. In claim 25, line 2, "ore" is misspelled. In claim 41, line 3, "or" should be cancelled. Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 11, 12, 15, 17, 19, 26, 29, 32-34, 38 and 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 is indefinite since it is not clear to what "including...profile" (lines 3-4) refers or modifies. There is no antecedent basis: in claim 7 for "said flavoring agent" (claim 11); in claim 11 for "said water soluble flavoring agents" (claim 12); in claim 14 for "said sweetener" (claims 15, 17); in claim 25 for "lactone monomers" (claim 26, line 2); in claim 1 for "the chewing gum polymers" (claims 32-34); in claim 1 for "the at least one biodegradable polymer" (claim 32); in claim 1 for "the biodegradable polymers" (claims 33-34); in claim 25 for "the carbonate monomer" (claim 41, line 2); and in claim 1 for "polyester polymers" and "the polymerization of cyclic ester monomers" (claim 42, lines 2-3). Claims 19 and 40 do not further limit the claim from which they depend due to the recitation of "0 %" in claims 19 and 40. Claim 38 is indefinite since it depends upon claim 1, which requires gum ingredients, but claim 38 does not include any gum base

Art Unit: 1794

ingredients. Even if included, claim 38 would be a duplicate of claim 1 and should be cancelled. Corrections are required without new matter.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 11-20, 22, 24-26 and 28-42 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldberg et al (WO 01/47368, pages 4-7, 9-15, 17, 19, 42). Goldberg et al discloses a chewing gum free of non-biodegradable polymers and including two different biodegradable polyester copolymers as claimed by applicant, having a molecular weight as claimed by applicant, present in an amount as claimed by applicant and obtained in the manner claimed by applicant (claims 1-6, 24-26, 32-38, 41, 42). The chewing gum also includes conventional chewing gum ingredients as claimed by applicant and in the amounts as claimed by applicant (claims 7, 8, 11-20, 22, 28-31, 37, 39, 40).

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. Finding the optimum amount of flavoring agent would require nothing more than routine experimentation by one reasonably skilled in this art.

Art Unit: 1794

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al in view of Grijpma et al (5,672,367, col. 3, line 4) or Li et al (6,153,231, col. 7, lines 60-61). It would have been obvious to include a medicinal or pharmaceutical ingredient as an active ingredient in the chewing gum of Goldberg et al since such an ingredient is a conventional chewing gum component, as evidenced by either secondary reference.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-20, 22-26 and 28-42 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims: 1-62 of copending Application No. 10/472,122; claims 1-54 of copending Application No. 10/472,154; claims 1-67 of copending Application No. 10/528,926; claims 1-64 of copending Application No. 10/528,930; claims 1-57 of copending Application No.

Art Unit: 1794

10/528,927; claims 1-55 of copending Application No. 10/529,137 and claims 1, 2, 10, 11, 13-18, 24-26 and 28-54 of copending Application No. 11/088,109. Although the conflicting claims are not identical, they are not patentably distinct from each other because the chewing gum claimed in the claims of each of said applications is merely an obvious variation of the chewing gum claimed by applicant in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur L. Corbin whose telephone number is (571) 272-1399. The examiner can normally be reached on Monday-Friday from 10:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/529,133

Art Unit: 1794

Page 6

A handwritten signature in black ink, appearing to read 'Arthur L. Corbin', is written over a circular stamp or seal.

Arthur L. Corbin
Primary Examiner
Art Unit 1794

2-21-08